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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/384,692	08/27/1999	BRIAN MITCHELL BASS	RAL999-0080	8165

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EXAMINER

DINH, KHANH Q

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 09/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/384,692

Applicant(s)

Bass et al

Examiner

Khanh Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 19, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above, claim(s) 14-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-42 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-13 drawn to a system and method of a control processor cooperating with an interface device to exchange data, classified in **class 370, subclass 335**.

II. Claims 14-25, drawn a communication device to control plurality of data queues, classified in **class 370, subclass 360**.

III. Claims 26-32 and 37, drawn to a mechanism for transporting control information system using a function generator, classified in **class 370, subclass 419**.

IV. Claims 33-36, 38-42, drawn to a system and method of using a control function to generate a guide frame to one of a plurality of media interface, classified in **class 370, subclass 351**.

2. Inventions I, II, III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as system and method of a control processor cooperating with interface device to exchange data, classified in a *different Class/Subclass*. Invention II has separate utility such as a communication device to control plurality of data queues, classified in a *different Class/Subclass*. Invention III has separate

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utility such as a mechanism for transporting control information system using a function generator, classified in a *different Class/Subclass*. Invention IV has separate utility such as a method for using a control function to generate a guide frame to one of a plurality of media interface, classified in a *different Class/Subclass*.

3. The inventions are distinct, each from the other, because of the following reasons:

(a) These inventions have acquired a separate status in the art as shown by their different classifications.

(b) The search required for each Group is different and not co-extensive for examination purposes.

For example, the searches for the three inventions would not be co-extensive because these Groups would require different searches on PTO's classification class and subclass as following:

the Group I search (claims 1-20) would require use of search **class 370, subclass 335** (not require for the inventions II, III, IV).

the Group II search (claims 21-25) would require use of search **class 370, subclass 360** (not require for the inventions I, III, IV).

the Group III search (claims 26-30) would require use of search **class 370, subclass 419** (not require for the invention I, II, IV).

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the Group IV search (claims 26-30) would require use of search **class 370, subclass 351** (not require for the invention I, II, III).

For the reasons given above restriction for examination purposes as indicated is proper.

4. Claims 1-13 are pending for examination.

#### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. During a telephone conversation with Mr. Cockburn on 9/24/2002 a provisional election was made with traverse to prosecute the invention of GROUP I, claims 1-13. Affirmation of this election must be made by applicant in responding to this Office action. Claims 14-42 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (h).

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9. Claims 1-13 are rejected under the judicially created doctrine of double patenting over claims 1-12 of U. S. Patent No.6,404,752. Although the conflicting claims are not identical, they are not patentably distinct from each other because the following reasons:

As to claim 1, claim 1 of the above patent recite all the limitations in claim 1 ( see col.29 lines 13-42). However, the claimed invention in the instant application is fully disclosed in the patent and it is **broader** than the claimed invention in the patent. No new invention, or new improvement is being claimed in the instant application. Applicant now is ***attempting to claim broadly that which had been previously described in more detail in the claims of the patent*** (In re Van Ornum, 214 USPQ 761 CCPA 1982).

Claim 1 in the instant application is made broader than claim 1 of the above patent by removing the steps of “ a self routing switching fabric device operatively connected to said interface device and directing data inbound to the apparatus from identifiable addresses to flow outbound from the apparatus to identified addresses”.

Furthermore, there is no apparent reason why Applicant was prevented from presenting and prosecuting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

As to claims 2 and 3, claim 2 of the above patent recite all the limitations in claims 2 and 3 ( see col.29 line 47 to col.30 line 6). However, the claimed invention in the instant application

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is fully disclosed in the patent and it is **broader** than the claimed invention in the patent. No new invention, or new improvement is being claimed in the instant application. Applicant now is ***attempting to claim broadly that which had been previously described in more detail in the claims of the patent*** (In re Van Ornum, 214 USPQ 761 CCPA 1982).

Claims 2 and 3 in the instant application are made broader than claim 2 of the above patent by removing the steps of "Said second interface device being operatively connected to said self routing switching fabric device and said interface device and said second interface device being linked one to other and cooperating so that data flow through the apparatus is divided therebetween".

Furthermore, there is no apparent reason why Applicant was prevented from presenting and prosecuting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

As to claim 4, claim 1 of the above patent discloses the input/output ports (see col.29 lines 31-34). Allen of the above patent does not specifically disclose the control point processor is remotely located from the interface device. However, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement the control point processor remotely from the interface device because it would have improved the data flow handling capability of network switches.

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As to claim 5, claim 4 of the above patent discloses all the limitations in claim 5 (see col.30 lines 19-56) except a housing, a backplane mounted in the housing and a plurality of printed circuit in the housing. However, the use of such interface device is generally well known in the art. It would have been obvious if not inherent to one of the ordinary skill in the art at the time the invention was made to implement such well known interface device in the system of Allen to directing the exchange of data because it would have enabled directing the exchange of data input/output ports and the flow of data through the data memory.

As to claim 6, claim 2 of the above patent discloses all the limitations in claim 6 (see col.29 lines 48-53).

As to claim 7, claim 2 of the above patent discloses all the limitations in claim 7 (see col.29 line 47 to col.30 line 13).

As to claim 8, claim 1 of the above patent discloses all the limitations in claim 5 (see col.29 lines 12-46) except a printed circuit board device. However, the use of such interface device is generally well known in the art. It would have been obvious if not inherent to one of the ordinary skill in the art at the time the invention was made to implement such well known interface device

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in the system of Allen to directing the exchange of data because it would have enabled directing the exchange of data input/output ports and the flow of data through the data memory.

As to claim 9, claim 1 of the above patent discloses all the limitations in claim 9 (see col.30 lines 19-56) except a housing, a backplane mounted in the housing and a plurality of printed circuit in the housing. However, the use of such interface device is generally well known in the art. It would have been obvious if not inherent to one of the ordinary skill in the art at the time the invention was made to implement such well known interface device in the system of Allen to directing the exchange of data because it would have enabled directing the exchange of data input/output ports and the flow of data through the data memory.

As to claim 10, claim 4 of the above patent recite all the limitations in claim 10 ( see col.29 line 47 to col.30 line 6). However, the claimed invention in the instant application is fully disclosed in the patent and it is **broader** than the claimed invention in the patent. No new invention, or new improvement is being claimed in the instant application. Applicant now is ***attempting to claim broadly that which had been previously described in more detail in the claims of the patent*** (In re Van Ornum, 214 USPQ 761 CCPA 1982).

Claim 10 in the instant application is made broader than claim 4 of the above patent by removing the steps of “ a self routing switching table..., a control point processor, a plurality of interface devices..., a semiconductor substrate, control point processor cooperating with said

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interface device by loading memory instructions ... and a plurality of said interface device being operatively connected with each of the input and output ports of said switching fabric device .”

Furthermore, there is no apparent reason why Applicant was prevented from presenting and prosecuting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

As to claim 11, claim 5 of the above patent recite all the limitations in claim 11 (see col.30 lines 57-59).

As to claim 12, claim 11 of the above patent recite all the limitations in claim 12 (see col.32 lines 43-48).

As to claim 13, claim 12 of the above patent recite all the limitations in claim 13 (see col.32 lines 49-58).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh, can be reached on (703) 305-9648. The fax phone numbers for this group are:

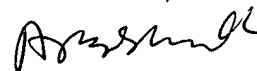
After Final: (703) 746-7239

Official: (703) 746-7239

Non-Official/ Draft: (703) 746-7240

*A shortened statutory period for reply is set to expire THREE months from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U.S.C. Sect.133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(A).*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.



AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

Khanh Dinh  
Patent Examiner  
Art Unit 2155  
September 26, 2002